

REMARKS

Claims 1-6 are pending in this application. By this Amendment, claims 1, 2, 4 and 5 are amended; and new claim 6 is added. Claim 5 is amended to address a claim objection.

No new matter is added to the application by this Amendment. Support for the features added to claim 1, 4 and 5 is found in Fig. 2, as originally filed, and within the specification, as originally filed, at, for example, page 4, lines 5 and 6 and page 5, lines 4-6. New claim 6 finds support in Fig. 1, as originally filed, and within the specification, as originally filed, at, for example, page 4, lines 5 and 6 and page 5, lines 4-6.

Reconsideration of the application is respectfully requested.

I. Objection to the Claims

Claim 5 was objected to for alleged informalities because the claim limitation recites “providing a security tag in selected filed” which should be “files”. This claim objection is respectfully traversed.

Claim 5 was amended to replace the term “filed” with the term “files” as suggested by the Patent Office.

Accordingly, withdrawal of the objection to the claims is respectfully requested.

II. Rejection Under 35 U.S.C. §102

Claims 1-5 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,594,796 to Grube et al. (hereinafter "Grube"). This rejection is respectfully traversed.

Prior to discussing the relative merits of the Patent Office's rejection, Applicants point out that unpatentability based on "anticipation" type rejection under 35 USC 102(b) requires that the invention is not in fact new. See *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302, 36 USPQ2d 1101, 1103 (Fed. Cir. 1995) ("lack of novelty (often called 'anticipation') requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee"). Anticipation requires that a *single reference* [emphasis added] describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art. See, *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

The principle of "inherency," in the law of anticipation, requires that any information missing from the reference would nonetheless be known to be present in the subject matter of the reference, when viewed by persons experienced in the field of the invention. However, "anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation, [or the reference] cannot inherently anticipate the claims." *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1373 [62 USPQ2d 1865] (Fed. Cir. 2002); *Hitzeman v.*

Rutter, 243 F.3d 1345, 1355 [58 USPQ2d 1161] (Fed. Cir. 2001) ("consistent with the law of anticipation, an inherent property must necessarily be present in the invention described by the count, and it must be so recognized by persons of ordinary skill in the art"); *In re Robertson*, 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999) (that a feature in the prior art reference "could" operate as claimed does not establish inherency).

Thus, when a claim limitation is not explicitly set forth in a reference, evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co.*, 948 F.2d at 1268. It is not sufficient if a material element or limitation is "merely probably or possibly present" in the prior art. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 [63 USPQ2d 1597] (Fed. Cir. 2002). See also, *W.L. Gore v. Garlock, Inc.*, 721 F.2d at 1554 (Fed. Cir. 1983) (anticipation "cannot be predicated on mere conjecture respecting the characteristics of products that might result from the practice of processes disclosed in references"); *In re Oelrich*, 666 F.2d 578, 581 [212 USPQ 323] (CCPA 1982) (to anticipate, the asserted inherent function must be present in the prior art).

The Patent Office alleges that Grube teach each and every feature recited in claims 1-5. Applicants respectfully disagree.

Grube discloses a technique to prevent pirates from distributing copyrighted information from illegal databases over a wireless network. Grube's security tags are

used in the data, which can be uniquely linked to authorized distributors. A gateway between a database and a wireless network tests data for the presence of these security tags and compares the security tags with the identity of the actual distributor, to determine whether the data has been sent by an authorized distributor. Thus, Grube, at best, is directed to passing material from anywhere into a wireless network only for authorized distributors and blocking pirated material based on comparing security tags with identities of actual distributors. See col. 3, line 30 – col. 4, line 8. Specifically, Grube discloses pirated material from other distributors is blocked by checking and determining whether a security tag in the material is assigned to the identity of the distributor. See col. 2, lines 44-54.

The presently claimed invention requires a gate device configured either to send a file to the connection only if the security tag is not found to be present in the file or to block the sending of the file to the connection if no security tag is found to be present in the file. In contrast, Grube teaches transmitting a file when the file contains a tag and the tag matches the source of the file. Grube does not disclose transmitting the file "only" if no security tag is found. Additionally, Grube teaches away from this, because the purpose of Grube is to transmit files from authorized source. Accordingly, Grube teaches that the tag must serve to identify the source, not that presence of the tag itself blocks transmission. Further, Grube teaches not sending a file if it does contain a security tag and the source of the file does not correspond to the security tag. Thus, Grube does not disclose blocking a file if it has no security tag. Moreover, Grube

teaches away from this, because the purpose of Grube is to use the security tag to enable selective blocking of transmissions from unauthorized sources.

Thus, Grube fails to teach or suggest a gate device that is configured to check a file sent from the local network domain to the connection for whether the file contains a security tag, and either (a) to send on the file to the connection only if the security tag is not found to be present in the file or (b) to block the sending of the file to the connection if no security tag is found to be present in the file as required in amended claims 1 and 4. Moreover, Grube fails to teach or suggest the steps of either (a) sending on those files if the security tags are not found in those files or (b) blocking those files if no security tags are found to be present in those files as recited in amended claim 5.

With respect to dependent claim 3, Applicants submit that nowhere does Grube teach or suggest encryption. At best, Grube teaches addition of a Cyclic Redundancy Code (CRC) to the material. See col. 4, lines 43-67. However, CRC is not encryption but merely adds more material without making such material unreadable. Therefore, Applicants submit that Grube fails to teach or suggest communicating computers that are arranged to encrypt a substantial part of the file when providing the security tag as required by claim 3.

It is believed that the Patent Office has not properly made their case that the present claims are properly rejected as being anticipated under 35 USC 102(b) in view of Grube.

Because the above-identified features of independent claims 1, 4 and 5 are

neither taught nor suggested by Grube, Grube cannot anticipate, and would not have rendered obvious, the features specifically defined in claims 1, 4 and 5 and the dependent claims of claim 1.

For at least these reasons, claims 1-5 are patentably distinct from and/or non-obvious in view of Grube. Reconsideration and withdrawal of the rejections of the claims under 35 U.S.C. §102(b) are respectfully requested.

III. New claim

Applicants take this opportunity to submit that Grube fails to teach or suggest one or more second connections for communication with an external network, one or more second gate devices coupled between the local network domain and the one or more second connections, wherein the one or more second gate devices are configured to check files sent from the local network domain to the one or more second connections for whether the files contain security tags, and either (a) to send the files to the one or more second connection if the security tags are not found to be present in the files or (b) to block the sending of the files to the one or more second connections if no security tags are found to be present in the files as required by new claim 6.

Therefore, new claim 6 is patentably distinct from and non-obvious over the cited reference.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-6 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Early and favorable action is earnestly solicited.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account
No. 14-1263.

Respectfully submitted,

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